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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,944	05/27/2005	Roland Kneer	0814.73128	8320

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EXAMINER	
WOLLSCHLAGER, JEFFREY MICHAEL	
ART UNIT	**PAPER NUMBER**
1732	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/536,944	KNEER, ROLAND	
	Examiner	Art Unit	
	Jeff Wollschlager	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 May 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the application admits of illustration by clear drawings to facilitate understanding of the invention. The numbering on the figures is unclear and the figures contain German text. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the preamble of claim 1 it is unclear whether the recitations are claimed process steps or product limitations. Claim 1 is also indefinite because the limiting effect of the term "uneven surface" is not clear. Further, the limitation "dust-like particles" is unclear as to its limiting effect. Additionally, the term "high oscillation frequency" claim 1 is a relative term which renders the claim indefinite. The term "high oscillation frequency" is not defined by the claim, the specification does

not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,276,558.

Claim 5 of U.S. Patent 6,276,558 claims the basic claimed process of producing a receptacle characterized in that at least one wall opening is formed with a cutting tool so that a hole is formed in the outer wall. The cutting tool is a knife which comprises and inclined flank.

Regarding claims 1 and 4, it is noted that the term "high oscillation frequency" is a relative term and the removal of dust-like particles is unclear as to its limiting effect. Further, the specification of the '558 patent teaches the knife is tubular (col. 5, lines 20). Producing an arc with a tubular knife would have been obvious to a person having ordinary skill in the art at the time of the claimed invention.

Claims 1 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,244,852.

Claim 1 of U.S. Patent 6,244,852 claims the basic claimed process of producing at least one wall opening in a receptacle in that a cut or a notch is cut or punched into the wall of the outer receptacle.

Regarding claims 1 and 4, it is noted that the term "high oscillation frequency" is a relative term and the removal of dust-like particles is unclear as to its limiting effect. Producing an arc or elongated slit/notch with a knife would have been obvious to a person having ordinary skill in the art at the time of the claimed invention.

Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,244,852 in view of Pollak (U.S. Patent 6,865,813) or Slocum (U.S. Patent 4,955,888) or Arnegger (U.S. Patent 5,69,257).

Regarding claims 1 –7, claim 1 of the '852 patent claims the process of producing at least one wall opening in a receptacle in that a cut or a notch is cut or

punched into the wall of the outer receptacle. The '852 patent does not claim that the cut or punch is made by a tool with a saw blade comprising teeth operating at frequencies of about 10,000 to 20,000 oscillations/minute to produce an opening that has the shape of an elongated slit or arc shape. However, Pollak (col. 3, lines 8-24), Slocum (col. 3, lines 1-37), and Arnegger (col. 1, lines 18; col. 3, lines 62-65) individually teach high frequency oscillation cutting devices for making small holes or cuts in material.

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to employ the cutting tools disclosed by Pollak, Slocum, or Arnegger in the method of cutting a opening in a receptacle as claimed in claim 1 of the '852 patent, for the purpose as taught by Pollak of employing an inexpensive tool, that has good stability in operation (col. 1, lines 30-40) or as taught by Slocum of improving the conformity of the cut-produced surfaces (col. 2, lines 7-11) or as taught by Arnegger of improving the cut characteristics (Abstract) while making very fine separating or parting cuts (col. 3, lines 62-65)

Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent 6,276,558 in view of Pollak (U.S. Patent 6,865,813) or Slocum (U.S. Patent 4,955,888) or Arnegger (U.S. Patent 5,69,257).

Regarding claims 1-7, claim 5 of U.S. Patent 6,276,558 claims the basic process of producing a receptacle characterized in that at least one wall opening is formed with

a cutting tool so that a hole is formed in the outer wall. The cutting tool is a knife that comprises and inclined flank. The '558 patent does not claim that the cut or punch is made by a tool with a saw blade comprising teeth operating at frequencies of about 10,000 to 20,000 oscillations/minute to produce an opening that has the shape of an elongated slit or arc shape. However, Pollak (col. 3, lines 8-24), Slocum (col. 3, lines 1-37), and Arnegger (col. 1, lines 18; col. 3, lines 62-65) individually teach high frequency oscillation cutting devices for making small holes or cuts in material.

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to employ the cutting tools disclosed by Pollak, Slocum, or Arnegger in the method of cutting a opening in a receptacle as claimed in claim 5 of the '558 patent, for the purpose as taught by Pollak of employing an inexpensive tool, that has good stability in operation (col. 1, lines 30-40) or as taught by Slocum of improving the conformity of the cut-produced surfaces (col. 2, lines 7-11) or as taught by Arnegger of improving the cut characteristics (Abstract) while making very fine separating or parting cuts (col. 3, lines 62-65)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kneer (U.S. Patent 6,276,558; issued August 21, 2001).

Regarding claims 1 and 4, Kneer teaches a method of producing a receptacle comprising at least one wall opening being formed by a tool having an uneven surface. The cutting is performed at a high frequency and removes dust-like material (Figure 1A; Figure 1C; col. 2, lines 44-67; col. 3, lines 10-67; col. 4, lines 8-38).

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nomoto et al. (U.S. Patent 6,266,943; issued July 31, 2001).

Regarding claims 1 and 4, Nomoto et al. teach a method of producing a receptacle comprising at least one wall opening being formed by a tool having an uneven surface. The cutting is performed at a high frequency and removes dust-like material to form a circular/arc opening (Abstract; Figures 2, 8, and 9; col. 7, line 64 – col. 8, lines 67; col. 14, lines 6-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kneer (U.S. Patent 6,276,558; issued August 21, 2001), as applied to claims 1 and 4 above, in view of view of Pollak (U.S. Patent 6,865,813) or Slocum (U.S. Patent 4,955,888) or Arnegger (U.S. Patent 5,69,257).

As to claims 2, 3 and 5-7, Kneer teaches the method of claims 1 and 4 as discussed in the 102(b) rejection above, but do not teach the tool comprising teeth operating at frequencies of about 10,000 to 20,000 oscillations/minute to produce an opening that has the shape of an elongated slit or arc shape. However, Pollak (col. 3, lines 8-24), Slocum (col. 3, lines 1-37), and Arnegger (col. 1, lines 18; col. 3, lines 62-65) individually teach high frequency oscillation cutting devices for making small holes or cuts in material.

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to employ the cutting tools disclosed by Pollak, Slocum, or Arnegger in the method of cutting a opening in a receptacle as claimed in claim 5 of the '558 patent, for the purpose as taught by Pollak of employing an inexpensive tool, that has good stability in operation (col. 1, lines 30-40) or as taught by Slocum of improving the conformity of the cut-produced surfaces (col. 2, lines 7-11) or as taught by Arnegger of improving the cut characteristics (Abstract) while making very fine separating or parting cuts (col. 3, lines 62-65)

Claims 2, 3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over, Nomoto et al. (U.S. Patent 6,266,943; issued July 31, 2001), as applied to claims

1 and 4 above, in view of view of Pollak (U.S. Patent 6,865,813) or Slocum (U.S. Patent 4,955,888) or Arnegger (U.S. Patent 5,69,257).

As to claims 2, 3 and 5-7, Normoto et al. teach the method of claims 1 and 4 as discussed in the 102(b) rejection above, but do not teach the tool comprising teeth operating at frequencies of about 10,000 to 20,000 oscillations/minute to produce an opening that has the shape of an elongated slit or arc shape. However, Pollak (col. 3, lines 8-24), Slocum (col. 3, lines 1-37), and Arnegger (col. 1, lines 18; col. 3, lines 62-65) individually teach high frequency oscillation cutting devices for making small holes or cuts in material.

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to employ the cutting tools disclosed by Pollak, Slocum, or Arnegger in the method of cutting a opening in a receptacle as claimed in claim 5 of the '558 patent, for the purpose as taught by Pollak of having employing an inexpensive tool, that has good stability in operation (col. 1, lines 30-40) or as taught by Slocum of improving the conformity of the cut-produced surfaces (col. 2, lines 7-11) or as taught by Arnegger of improving the cut characteristics (Abstract) while making very fine separating or parting cuts (col. 3, lines 62-65)

Conclusion

All claims are rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,109,468 to Kneer teaches elongated cuts made into the wall of the outer receptacle with a knife, punching tool or laser (col. 3, lines 39-55)

U.S. Patent 5,567,377 to Nishigami et al. teaches an analogous method of manufacturing a multilayer bottle (Figure 4).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager
Examiner
Art Unit 1732

October 28, 2006

CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER
10/30/06